



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/254,118 05/19/99 TATSUMI

K 52433/544

EXAMINER

MM91/0213

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CHAMBLISS, A

ART UNIT

PAPER NUMBER

2614

DATE MAILED:

02/13/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**

Application No.

09/254,118

Applicant(s)

TATSUMI ET AL.

Examiner

Alonzo Chambliss

Art Unit

2814

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 December 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☐ Notice of References Cited (PTO-892)                      18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      20) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Prosecution Application***

1. The request filed on 12/1/00 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/254,118 is acceptable and a CPA has been established. An action on the CPA follows.

***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

3. The information disclosure statement submitted on 2/25/99 was filed before the mailing date of the Non Final rejection on 6/6/00. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the petition is granted and the examiner is considering the information disclosure statement.

***Response to Arguments***

4. Applicant's arguments filed 12/1/00 have been fully considered but they are not persuasive.

Applicant alleges that Hoshiba can not be prior art under 35 U.S.C. 102(a) because this application claims convention priority under 35 U.S.C. 119 from Japanese Patent Application No. 8-244268 filed in Japan on 8/27/96, which is prior to the filing

date of 11/18/97. This argument is respectfully deemed to be unpersuasive because Hoshiba et al. (U.S. 5,687,901) has a filing date of 11/14/95. Therefore, Hoshiba can be used as prior art in a 102(a) rejection. Furthermore, this application is not filed after May 29, 2000, which means this application is not effected by the recent amendments to the patent laws.

Applicant alleges that Hoshiba does not teach a substrate for mounting semiconductor devices. This argument is respectfully deemed to be unpersuasive because Hoshiba teaches balls bonded to electrode pads of a printed-circuit board (see col. 9 lines 21-25).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(a) as being anticipated by Hoshiba et al. (U.S. 5,687,901), for the same reasons as set forth in the previous Office action, paragraph 2, paper no. 7.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 5, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshiba et al. (U.S. 5,687,901) as applied to claim 1 above, and further in view of Le Coz et al. (U.S. 5,762,258), for the same reasons as set forth in the previous Office action, paragraph 3, paper no. 7.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. It is cited primarily to show processes of packaging a semiconductor device, which are similar to the process of the instant invention.

Any inquiry concerning the communication or earlier communications from the examiner should be directed to Alonzo Chambliss whose telephone number is (703) 306-9143. The fax phone number for this Group is (703) 308-7722 or 7724. Any inquiry of a general nature or relating to the status of this application or proceeding

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should be directed to the Group receptionist whose telephone number is (703) 308-7956.

AC

AC/February 8, 2001

  
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SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800